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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,213	01/04/2002	Syuuichi Azechi	0171-0808P-SP	3484

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EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,213

Applicant(s)

AZECHI ET AL.

Examiner

Michael J Feely

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AS-6

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Pending Claims

1. Claims 1-9 are pending.

Priority

2. On page 7 of Applicants' Amendment/Remarks, filed July 3, 2003, Applicant states that a certified translation of the foreign priority document was concurrently filed. However, this translation document has not been received; hence, it is not currently part of the case record.

Claim Rejections - 35 USC § 112 1st Paragraph

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a silicone rubber adhesive composition used to form an integrally molded article with a *thermoplastic* resin, wherein a cured product of the silicone rubber adhesive composition provides a greater bond strength to the *thermoplastic* resin than a *metal* mold used for forming the integrally molded article, does not reasonably provide enablement for a silicone rubber adhesive composition used to form an integrally molded article with *any organic* resin, wherein a cured product of the silicone rubber adhesive composition provides a greater bond strength to the *organic* resin than a *any* mold used for forming the integrally molded article. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

As set forth on lines 15-19 of page 3 and lines 3-17 of page 19, the silicone rubber adhesive composition is integrally molded with thermoplastic, not any organic resin. As set forth on lines 3-6 of page 20, the integrally molded article is molded in a metal mold, not any mold; hence, the relative bond strength of the silicone rubber adhesive composition applies to metal molds, not any mold.

5. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide support for the following limitation, "the cured product of said silicone rubber adhesive composition providing a greater bond strength to said organic resin than *any* mold used for forming the integrally molded article." The bond strength property with respect to *any* mold is not established; rather, it is only established for metal mold materials. This is a new matter rejection.

6. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a silicone rubber adhesive composition that *most often* provides a greater bond strength to organic resins than to metals, does not reasonably provide enablement for a silicone rubber adhesive composition that *always* provides a greater bond strength to organic resins than to metals. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

As set forth on lines 13-14 of page 4, silicone rubber adhesive composition does not *always* provide greater bond strength to organic resins than to metals. As set forth on lines 15-19 of page 3 and lines 3-17 of page 19, the silicone rubber adhesive composition *most often* provides greater bond strength to *thermoplastic* resins than to metals, not any organic resin. Furthermore, it is unclear how this property can encompass all metals. Applicants describe metals such as steel, stainless steel, chromium-plated metals, and nickel-plated metals. It is unclear if this adhesion property would also be achieved with respect to metals such as copper, silver, platinum, and gold.

7. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-3 and 6-9 disclose that the cured product of the silicone adhesive composition provides greater bond strength to any organic resin than to any mold used for forming the integrally molded article. It is unclear how this property could be achieved with any combination of organic resins and mold materials. Specifically, if the organic resin was a PTFE (Teflon) resin, it is unclear how the bond strength of the silicone adhesive composition with respect to the PTFE would have been greater than the bond strength of the silicone adhesive composition respect to a metal, a ceramic mold or a polymeric mold.

Claim Rejections - 35 USC § 112 2nd Paragraph

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the cured product of said silicone rubber adhesive composition" with out any previous mention of a cured product. There is insufficient antecedent basis for this limitation in the claim. A suggested change would be: --wherein a cured product of said silicone rubber adhesive composition--. Claims 2-3 and 6-9 are rejected because they depend on claim 1.

Claim 6 recites the limitation "the organosilicon compound having at least one linear or cyclic siloxane structure" in the composition of claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102/103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. The rejection of claims 1 and 3, under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Azechi (US Pub. No. 2002/0032270) has been withdrawn.

12. The rejection of claim 4, under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Azechi (US Pub. No. 2002/0032270) stands for the reasons set forth in section 5 of the previous Office action.

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13. The rejection of claims 1 and 3, under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fujiki et al. (US Pub. No. 2002/0028335) has been withdrawn.

14. The rejection of claim 4, under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fujiki et al. (US Pub. No. 2002/0028335) stands for the reasons set forth in section 6 of the previous Office action.

15. The rejection of claims 1-3, under 35 U.S.C. 103(a) as obvious over Morita et al. (US Pub. No. 5,530,075) in view of Meguriya et al. (US Pat. No. 5,714,265) has been withdrawn.

Allowable Subject Matter

16. Claim 5 is allowed for the reasons set forth in sections 8 and 9 of the previous Office action.

Response to Arguments

17. Applicants' arguments with respect to the rejection(s) of claim(s) 1 and 3, under 35 U.S.C. 102 or 103 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the rejections over Azechi (US Pub. No. 2002/0032270) and Fujiki et al. (US Pub. No. 2002/0028335), Applicants intended to overcome the rejections by providing a certified translation of the foreign priority document; however, the certified translation document has not been received. Regardless, the argument is now moot in view of the new ground(s) of rejection under 35 U.S.C. 112, first and second paragraphs.

18. Applicants' arguments with respect to the rejection(s) of claim(s) 4, under 35 U.S.C. 102 or 103 have been considered but they are not persuasive.

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Regarding the rejections over Azechi (US Pub. No. 2002/0032270) and Fujiki et al. (US Pub. No. 2002/0028335), Applicants intended to overcome the rejections by providing a certified translation of the foreign priority document; however, the certified translation document has not been received. Hence, the rejection stands.

19. Applicants' arguments, with respect to the rejection(s) of claim(s) 1-3 under 35 U.S.C. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made under 35 U.S.C. 112, first and second paragraphs.

It should be noted that Applicants make reference in their arguments to a Declaration signed on 30 May 2003. This Declaration has not been received, and is not currently part of the case record.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Feely whose telephone number is 703-305-0268. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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Michael J. Feely
September 12, 2003

A handwritten signature in black ink, reading "Robert A. Dawson". The signature is fluid and cursive, with a long horizontal stroke at the end.

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700